

### **R e m a r k s**

Claims 1, 2, 4 and 9-11 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,112,191 to Burke. Claims 3, 5-8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Burke in view of U.S. Patent No. 6,164,533 to Barton.

Claims 2 and 3 have been canceled and new claims 12-28 have been added.

Neither Burke or Barton teach or suggest the methods of claims 1 and 4-28.

#### Claims 1 and 4-13

Independent claims 1 and 9 recite a method of investment by a purchaser at a point of sale location using “a predetermined dollar investment amount” for making an on-demand investment that is independent of the point-of-sale transaction amount. Such a method for investment is described in, for example, paragraph 33 of the Specification:

If however, the customer chooses to make an investment, step 90, the customer selects the amount to invest, step 92, and then confirms that the selected amount is correct, step 94. In the preferred embodiment, the customer/investor will select investment amounts in five dollar increments; however, any monetary increment can be used. Additionally, for ease of investing, the investor could choose a predetermined investment amount for all on-demand investment transactions. This predetermined amount would be selected when the customer enrolls in the investment program with their financial institution, and will become part of the customer's investment-preference information.

Neither Burke nor Barton, separately or combined, teach or suggest the methods of claims 1 and 9. Nowhere does Burke disclose where a user (or SP) chooses a predetermined dollar (and/or amount in cents); Burke only discloses rounding up to the next dollar or selecting an overpayment at the time of the point-of-sale. In fact, in the rejection, the Examiner concedes

that “Burke does not specifically disclose that the investment-preference information includes any predetermined investment amount for the on-demand investment, as the investment amount in the method of Burke is specified at the point-of-sale location at the time of sale.” (March 1, 2004 Office Action, p. 3.)

The Examiner, in the March 1 Office Action, cites to Barton (column 5, lines 44-50), and states that Barton discloses investment-preference information which includes a predetermined investment amount for the on-demand investment. Although this portion of Barton discloses that a user may choose a percentage of a transaction amount, this is clearly not a predetermined dollar amount that is independent of the point-of-sale transaction. Thus, Barton does not teach or suggest a method of investment by a purchaser at a point of sale location using “a predetermined dollar investment amount” for making an on-demand investment.

In fact, Barton specifies four modes for selecting an investment amount: (1) using a dollar amount based upon a percentage of a point-of-sale transaction amount, (2) rounding up to the nearest dollar amount based upon the point-of-sale transaction amount, (3) presenting a coupon indicating an investment amount, and (4) providing the change received in the course of a point-of-sale transaction. (Barton, col. 2, lines 25-35.) Barton, however, does not teach or suggest investing a predetermined amount (which is set, for example, by a user when enrolling in an investment program) regardless of the amount that the point-of-sale transaction involves.

For the reasons stated above, neither Burke nor Barton, separately or combined, teach or suggest the claimed methods recited by independent claims 1 and 9, and these claims are

therefore patentable over the cited references. In addition, because claims 4-8 and 10-13 depend from either independent claims 1 and 9, these claims are also patentable over the cited references.

#### Claims 14-28

Independent claim 14 recites a method of investing, wherein a request to make an investment in a first investment account that is designated by a user as a primary investment account is received, and at least a portion of the investment is automatically contributed into a second investment account that is designated by the user as a secondary investment account, if making the investment in the first investment account would violate at least one predetermined rule.

In addition, independent claims 21 and 28 recite, *inter alia*, a method of investing, wherein a request to make an investment is received from a purchaser at a point of sale location, an investment-preference relating to a first investment choice and a second investment choice is identified, wherein the first investment choice and the second investment choice are designated by the user, and a contribution to the second investment choice is made if an attempt to contribute to the first investment choice fails (claim 21) or if the total amount of the first investment choice is greater than the predetermined maximum amount (claim 28).

Accordingly, each of independent claims 14, 21 and 28 recite a method for investing wherein at least a portion of the investment is contributed to a second investment choice/second investment account upon a predetermined event -- *i.e.*: if making the investment in the first investment account violates at least one predetermined rule (claim 14); if attempting to contribute the investment contribution amount to a first investment choice fails (claim 21); or if a

total amount of the first investment choice is greater than a predetermined maximum amount (claim 28). (See, e.g., Specification, ¶¶ 0014 and 0036.)

Neither Burke nor Barton, separately or combined, teach or suggest the claimed invention. Burke is directed to a technique for payors to deposit funds in an account arising from financial transaction from a payor to a payee. (See, e.g., col. 1, lines 57-62.) Although Burke provides a payor with different contribution choices, it nowhere teaches or suggests that a user can establish first and second accounts (or investment choices), wherein a portion of funds are directed from the first investment account (or first investment choice) to a second investment account (second investment choice), upon the occurrence of a predetermined event, such as meeting a maximum account value limit or funds contribution limit. In fact, the user in Burke must specify to where funds are contributed. (See, e.g., col. 6, lines 3-6.)

Barton is directed to a technique for automatically contributing funds to a savings program upon making a purchase. (See Abstract.) Although Barton discloses an example in which funds are contributed to an IRA (see, e.g., col. 7, lines 55-66) -- an account that has a maximum contribution amount -- nowhere does it teach or suggest how funds that exceed such a maximum are invested. Whereas the claimed invention is directed to designating a first investment choice and a second investment choice, wherein, upon a predetermined event, contributions are redirected to the second investment choice, Barton fails to teach or suggest such an investment technique.

In the Office Action, the Examiner indicated that alternative accounts are self-evident with respect to IRA's because such accounts impose contribution maximum amounts.

Although IRA accounts impose a maximum contribution amount, the Examiner has not provided any reference(s) that teach or suggest designating by a user a first and second account such that funds directed to a first account (or investment choice) may be automatically redirected to a second account (or investment choice) upon a predetermined event.

For the reasons stated above, neither Burke nor Barton, separately or combined, teach or suggest the claimed methods recited by independent claims 14, 21 and 28, and these claims are therefore patentable over the cited references. In addition, because claims 15-20 and 22-27 depend from independent claims 14 and 21, respectively, these claims are also patentable over the cited references.

In view of the foregoing, each of claims 1 and 4-28 is believed to be in condition for allowance. Accordingly, reconsideration of these claims is requested and allowance of the application is earnestly solicited.

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